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In re Application of
MORGAN et al.
U.S. Application No.: 10/576,122
PCT No.: PCT/US04/34913
Int. Filing Date: 20 October 2004
Priority Date: 21 October 2003
Attorney Docket No.: 564462012800
For: METHODS FOR MAKING
SIMVASTATIN AND INTERMEDIATES

DECISION ON PETITION
UNDER 37 CFR 1.47(a)

This decision is issued in response to applicants' "Petition under 37 CFR 1.47(a) to File on Behalf of a Missing Inventor" filed 23 May 2007 to accept the application without the signature of joint-inventor, Zilin Huang. The required petition fee of \$200.00 has been submitted.

BACKGROUND

On 20 October 2004, applicants filed international application PCT/US04/34913 which claimed a priority date of 21 October 2003. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 21 April 2006.

On 18 April 2006, applicants filed a transmittal letter for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; and an application data sheet.

On 23 October 2006, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an oath or declaration. Furthermore, the Notification indicated that a Sequence Listing had not been filed as required by 37 CFR 1.821(c) and (e). The notification set a two-month time limit in which to respond.

On 23 May 2007, applicants filed a Petition under 37 CFR 1.47(a) and a five-month extension of time.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the nonsigning joint inventor. Items (1) and (3) have been satisfied.

As to item (2), petitioner states that Zilin Huang cannot be found or reached after diligent effort. Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions.

A review of the present petition reveals that petitioner has not provided an acceptable showing that a diligent effort was made to locate the nonsigning inventor, Zilin Huang. The Declaration of Linda Sabido states that "on 02 April 2007, 16 April 2007, and 26 April 2007, she sent a Rule 63 Declaration to Zilin Huang, at his last known address, via first class mail and registered mail (Fedex). The letters were returned to sender." However, the multiple mailings to the nonsigning inventor's last known address does not constitute a "diligent" effort to locate the inventor. Additionally, Ms. Sabido states that she attempted to contact Zilin Huang by telephone but the telephone numbers were disconnected. However, the declaration fails to include evidence that alternative means were employed, such as a search of telephone and/or Internet directories, to locate Zilin Huang. As stated above, copies of documentary evidence such as internet searches, certified mail return receipt, cover letter of instructions, telegrams, etc., should be supplied by a person having firsthand knowledge of the facts.

As to Item (4), the declaration is not in compliance with 37 CFR 1.497(a)-(b). Petitioner has provided a defective executed composite declaration. A composite declaration under 37 CFR 1.497(a)-(b) requires that the declaration must be complete and

identify each inventor in each set of declarations provided. The composite declaration is defective because it contains multiple duplicate sheets (see page 4). This suggests that the enclosed declaration was constructed from numerous complete declarations or that the inventors forwarded to counsel only the signature pages of the declaration. Either alternative renders the submitted declaration defective under 37 CFR 1.497. While each inventor need not execute the same oath or declaration, where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration. (See MPEP 201.03 B. Oath or Declaration.)

For the reasons stated above, it would not be appropriate to accept the application without the signature of Zilin Huang under 37 CFR 1.47(a) at this time.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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